

Wilmington
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REPLY
BRIEF

P-5543 PATENT
IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of Brian Feeney et al.

Serial No.: 09/479,985

Examiner: S. Wong

Filing Date: January 10, 2000

Group Art Unit: 3711

For: GAME BALL WITH A URETHANE GUM RUBBER SURFACE

Box AF

Commissioner for Patents & Trademarks

Washington, DC 20231

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GROUP 3700

Sir:

APPELLANTS' REPLY BRIEF UNDER 37 C.F.R. § 1.193

Appellants hereby present their Reply to the Examiner's Answer mailed September 17, 2002.

Appellants believe that no fees required under § 1.17 are required, but if an extension of time for filing this brief or any other fee is required, please charge any fees or credit any overpayment to Deposit Account No. 17-0150.

CERTIFICATE OF MAILING/TRANSMISSION (37 C.F.R. 1.8a)

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XX transmitted by facsimile to the Patent and Trademark Office to Examiner S. Wong in TC3700 at 703-872-9303.

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Before turning to the merits of the present appeal, Appellants feel it is necessary to address an assertion by the Examiner in his Answer under (7) Grouping of Claims. The Examiner states that "appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because the appellant fails to argue why the groups are separately patentable." Appellants respectfully disagree. On pages 3 to 4 of the Appeal Brief, Appellants state that the claims are separately grouped, and then support for separate patentability is explained throughout the Brief, in the Summary of the Invention as well as in the Arguments. Each independent claim recites different aspects of the present invention.

In the present appeal, the issues presented to the Board are: Whether claims 1 to 8, 10 to 14, 16 and 22 are obvious under 35 U.S.C. § 103(a) over Walker et al. (U.S. Patent No. 5,310,178) in view of "Manual for the Rubber Industry"; whether claims 9 and 15 are obvious under 35 U.S.C. § 103(a) over Walker et al. (U.S. Patent No. 5,310,178) in view of "Manual for the Rubber Industry" and Schindler et al. (U.S. Patent No. 5,636,835); and whether claims 1 to 16 and 22 are obvious under 35 U.S.C. § 103(a) over Molitor et al. (U.S. Patent No. 3,119,618) in view of "Manual for the Rubber Industry".

In the Examiner's Answer, the Examiner continues to focus on and direct attention to the "Manual for the Rubber Industry", and he states that "the motivation [to combine] lies within the teachings of the "Manual for the Rubber Industry". The inventors of the basketball of Walker et al. were concerned with providing a cover that provided improved wear and rebound characteristics" (page 3 of Examiner's Answer). Appellants do not dispute Walker et al.'s concerns, although this is not the primary concern. Appellants dispute the statement that "[s]urely, one of ordinary skill in the art would modify the teachings of Walker et al. (to replace the synthetic cover with a cover of vulcanized urethane gum rubber) should he find a material which is advertised as having improved upon the very mechanical characteristics of which Walker et al. was concerned." If the primary concern of Walker et al. was to find a ball having improved wear and rebound characteristics, then the Examiner's statement might be true. But, as Appellants have pointed out, Walker et al. is most concerned with providing a high

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quality basketball having an improved synthetic cover with superior characteristics like real leather covered balls. Therefore, the Examiner's motivation or reason to combine the references is clearly irrelevant, since Walker et al. is not concerned with a rubber basketball and would not consider a urethane gum rubber an improvement, but rather an inferior type of cover. One skilled in the art reading Walker et al. would not have any desire or motivation to replace the synthetic cover with leather-like feel with a rubber cover since Walker et al. teaches that rubber covers are inferior to leather and synthetic leather covers. Additionally, Walker et al. teaches a higher quality cover having insert panels, not a molded rubber cover such as that of Appellants.

The Examiner further stated that "appellant continues to hinge his arguments solely on the fact that Walker et al. teaches a synthetic leather cover and not consider the references and its teachings as a whole" (Examiner's Answer page 4). Appellants respectfully submit that this is exactly what the Examiner himself is doing. The Examiner conveniently forgets that Walker et al. is directed specifically to higher quality, synthetic basketballs having cover materials that are similar in feel and wear to leather and are made of insert panels. Therefore, one would not replace the synthetic cover with a molded cover formed of vulcanized gum rubber, as stated by the Examiner, because this would provide an inferior cover as compared to the cover of Walker et al.

Regarding the relevance of Appellants' statement that the cover of Walker et al. is not a polyurethane rubber cover, and the Examiner's answer (page 5), Appellants again reiterate that Walker et al. is not directed to a rubber cover, but instead, a synthetic cover with panel inserts having the feel and characteristics of leather. The Examiner is attempting to say that Walker et al. is one type of rubber cover, and it can easily be replaced by the urethane gum rubber material, as taught by the "Manual for the Rubber Industry", but as previously explained, this is not the case. The Examiner has mischaracterized the teachings of Walker et al. because the cover of Walker et al. is not a polyurethane rubber cover, but instead a synthetic cover produced using a polyurethane solution and polymeric fibers. The polyurethane material that is used in the cover of Walker et al. is only used to impregnate polymeric fibers (preferably nylon

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or polyester) and to simulate leather, thus providing a softer feel on the cover at a reduced cost as compared to high grade leathers. The polyurethane of Walker et al.'s cover is not a polyurethane rubber; therefore one of ordinary skill in the art would not be motivated to replace Walker et al.'s cover with a urethane rubber cover.

Regarding the combination of Molitor et al. in view of the "Manual for the Rubber Industry", Appellants respectfully submit that the Examiner has engaged in impermissible hindsight reconstruction. Molitor et al. is directed to a ball with a sponge layer between the inner carcass and the outer cover to enhance handling when gripped. Molitor et al. do not disclose specific types of cover materials at all because the invention is primarily concerned with the sponge layer of the ball, which improves the grip.

Appellants' game ball comprises a layer of vulcanized urethane gum rubber to improve durability and abrasion resistance, and a person of ordinary skill in the art would have no guidance from Molitor et al. regarding any particular type of cover material. The Examiner has impermissibly picked only the portion of the references that would support his position, to the exclusion of the other parts necessary to appreciate what the references suggest to one skilled in the art. By focusing on the one cover type (i.e., rubber) instead of the full intent and disclosure of Molitor et al., the Examiner has ignored the clear teaching in patentee's specification regarding improved rubber covers for game balls. The Examiner has impermissibly made an inference that all covers could be lumped together into one category and used interchangeably. The Examiner then cites a secondary reference, "Manual for the Rubber Industry", to provide a replacement cover material and states that the motivation to combine the references is provided by the secondary reference itself. Appellants respectfully submit that the only guidance is that supplied by the Examiner in making the rejection. When the prior art references require a selective combination to render obvious a subsequent invention, there must be some reason for the combination other than hindsight gleaned from the invention itself. Something in the prior art as a whole must suggest the desirability of making the combination. The Examiner has failed to show the desire, or motivation, to combine Molitor et al. with "Manual for the Rubber Industry".

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CONCLUSION

In view of the above, Appellants respectfully submit that claims 1 to 16 and 22 are non-obvious and patentable over the cited references. Accordingly, it is respectfully requested that the Examiner's rejection of claims 1 to 16 and 22 be reversed.

Respectfully submitted,

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